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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

OSMAN, RAMY M

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,792

Applicant(s)

HAINES ET AL.

Examiner

Ramy M Osman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This communication is responsive to the amendment filed on July 6, 2004. Claims 1-20 are pending.
2. Examiner acknowledges the typographical errors on page 2 of the Office Action sent on 4/5/2004. Paragraph 3 should be changed from “claims 1-7,11-19 and 21” to “claims 1,2,6 and 7”. It is clear that there is no claim 21 in the application. Every claim has been addressed with a rejection and therefore the rejections stand. A rejection of the remaining claims are included.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because multiple reference characters have been used to designate a single element:

In figure 1, numbers 18 & 20 refer to the same element, and numbers 22 & 23 refer to the same element.

In figure 2, numbers 14 & 16 refer to the same element, and numbers 23 & 46 refer to the same element.

In figure 3, numbers 12 & 150 refer to the same element, and numbers 12 & 48 refer to the same element.

In figure 4a, numbers 210 & 212 refer to the same element, and numbers 250 & 12 refer to the same element, and numbers 12 & 48 refer to the same element.

If applicant wishes to distinguish between two items, then two different diagrammatic elements are needed in the figures. Otherwise a single diagram element should be designated by a single reference number.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

There is no reference number 10 as mentioned on page 5 line 16, page 7 line 9, page 8 and throughout the rest of the specification.

Figure 2 fails to show the elements as mentioned on page 6: end user 21, interaction site 17, administrator 121, interface 210, etc.

Figure 3 has the same deficiencies as figure 2, where the specification mentions elements that applicant failed to include, like: reference number 210, and reference number 41.

Figure 4 is missing reference number 310.

Applicant is requested to correct the drawings.

5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities: On page 15 line 31, the '5' in "OpenView 5" is not clear whether this is a version number for OpenView or if it is a reference number representing OpenView in a figure..

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 and 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language of lines 5 and 6 are unclear. It is not clear whether the signal is being sent to establish a communication link or if there simply exists a communication link for the coupling of the devices.

Line 8 is unclear because it does not specify which messaging system is being referred to: the computer messaging system or the peripheral messaging system.

9. Claims 2,10 and 13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite. It is unclear how the user site comprises a web server. The specification on page 10 lines 9-19 mentions otherwise: "embedded web server of computer peripheral device". It shows that the embedded web server is on the peripheral device and not on the interaction site. Figure 1 shows

that the embedded web server is comprises within the peripheral device and not within the workgroup administrator interface as mentioned in claim 13.

10. Claim 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The claim language is unclear. Does the peripheral device comprise a web server, personal computer and a peripheral device; or is the claim meant to mean that the peripheral device just comprises a web server.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-4,6-9,12,13 and 15 are rejected under 35 U.S.C. 102(e) as being unpatentable over Hayward et al. (U.S. Patent No. 6,798,997).**

3. In reference to claims 1 and 8, Hayward teaches a consumable order-assistance system for computer peripheral devices (see Abstract), comprising:

a personal computer having a messaging system (column 3 line 38 – column 4 line 20 and claim1),

at least one computer peripheral device having a messaging system (column 4 lines 10-20 & 32-46, column 5 lines 5-23 and claim 1),

a communication link signal coupling the personal computer with a provider of a consumable for the computer peripheral device (column 3 lines 38-67, column 5 lines 19-67 and claim 4, Hayward discloses an Internet connection between the computer and the peripheral manufacturer), and

a user interaction site configured to receive a notification from the computer peripheral device via the messaging system of a need to order a consumable (Summary, column 5 lines 5-60, column 6 lines 1-25 and column 8 lines 24-32),

wherein the user interaction site is provided within one of: a single connection environment as an end user interface; an unmanaged network environment as a workgroup administrator interface; and a server-based centralized network environment as a centralized system administrator interface (Summary, column 5 lines 5-60, column 6 lines 1-25 and column 8 lines 24-32).

Claim 8 recites “or” on line 11 which means it can any of the three: a user interface, a workgroup administrator interface or a centralized administrator interface. Hayward teaches a user interface.

4. In reference to claims 2,9 and 12, Hayward teaches consumable order-assistance system of claim 1 wherein the personal computer and the computer peripheral device are connected with a bus, and wherein the user interaction site comprises a printer driver of the personal computer provided within a single-connection environment (column 5 lines 15-17, Hayward discloses a bus connection and peripheral firmware communicating with an application on the computer).

5. In reference to claims 3,4,10,13 and 15, Hayward teaches consumable order-assistance system of claim 1, wherein the personal computer and the computer peripheral device are

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provided within an unmanaged network environment, the user interaction site comprises an embedded web server of the computer peripheral device, and the embedded web server generates and forwards a message to a user at the personal computer to prompt ordering of a consumable (column 8 lines 25-32 and column 9 lines 1-50).

6. In reference to claim 6, Hayward teaches a consumable order-assistance system of claim 1 wherein the user interaction site comprises a user interface of the personal computer (Summary and column 5 lines 5-50, Hayward discloses a computer user interface).

7. In reference to claim 7, Hayward teaches a consumable order-assistance system of claim 1 wherein the user interaction site comprises a user interface for facilitating user access to the computer peripheral device to receive notification of a need to order a consumable for the computer peripheral device (Summary, column 5 lines 5-60, column 6 lines 1-25 and column 8 lines 25-32, Hayward discloses a user interface for receiving notification to order consumables for a computer peripheral device).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5,11 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Hayward et al. (U.S. Patent No. 5,812,776) in view of Kageyama (U.S. Patent No. 6,333,790).

10. Hayward teaches a consumable order-assistance system of claim 1. Hayward fails to explicitly teach wherein the user interaction site comprises a centralized administrator interface comprising a centralized purchaser, and wherein a centralized order-assistance tool of a network server delivers a notification to the centralized purchaser of a need to order a consumable. However, Kageyama teaches an administrator interface as a centralized purchaser receiving notification from a network, to order consumables (column 2 lines 39-67 and column 12 line 22 – column 13 line 51).

It would have been obvious for one of ordinary skill in the art to modify Hayward by making the consumable ordering system within a centralized administrator interface comprising a purchaser as per the teachings of Kageyama so that the consumable status of a variety of peripheral devices can be monitored from a central source, and receive order notification.

11. Claims 16-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Hayward et al. (U.S. Patent No. 5,812,776) in view of Skaaning et al (U.S. Patent No. 6,535,865).

12. In reference to claims 16 and 17, Hayward teaches a method of providing order assistance, comprising:

providing a computer peripheral device, a personal computer having extending between the computer peripheral device and the personal computer, and a user interaction site (column 3 line 38 – column 4 line 20, column 5 lines 5-67 and claim1);

based on the determined environment, providing the user interaction site in the form of : a user interface when the network environment comprises a single-connection environment; an embedded web server when the network environment comprises an unmanaged network environment; and a centralized system administrator interface when the network environment comprises a server-based, centralized network environment (Summary, column 5 lines 5-60, column 6 lines 1-25 and column 8 lines 24-32).

Hayward fails to explicitly teach determining an environment in which the computer peripheral device and the personal computer are provided by detecting the presence of a parallel cable or the presence of a network environment; and for the case where the presence of a network environment is detected, further broadcasting a discovery protocol to detect the presence of a centralized order-assistance solution. However, Skaaning teaches accommodating network communication depending on a network setup (column 1 lines 15-17, column 8 lines 33-65 and column 25 lines 1-25).

It would have been obvious for one of ordinary skill in the art to modify Hayward by determining an environment in which the computer peripheral device and the personal computer are provided as per the teachings of Skaaning so that multiple computer network setups can be accommodated.

13. In reference to claim 18, Hayward teaches the method of claim 16 wherein the network environment comprises a single-connection environment, the user interface site comprises an interface to a consumable order assistance computer program resident on the personal computer,

and the program provides an order location to a user for purchasing a consumable (column 5 lines 15-17).

14. In reference to claim 19, Hayward teaches the method of claim 16 wherein the computer peripheral device comprises an embedded web server, the network environment comprises an unmanaged network environment, and the embedded web server initiates ordering of a consumable in response to a detected need to replenish the consumable (column 8 lines 25-32 and column 9 lines 1-50).

11. Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Hayward et al. (U.S. Patent No. 5,812,776) in view of Skaaning et al (U.S. Patent No. 6,535,865) in further view of Kageyama (U.S. Patent No. 6,333,790).

Hayward teaches a consumable order-assistance system of claim 16. Hayward fails to explicitly teach wherein the user interaction site comprises a centralized administrator interface comprising a centralized purchaser, and wherein a centralized order-assistance tool of a network server delivers a notification to the centralized purchaser of a need to order a consumable.

However, Kageyama teaches an administrator interface as a centralized purchaser receiving notification from a network, to order consumables (column 2 lines 39-67 and column 12 line 22 – column 13 line 51).

It would have been obvious for one of ordinary skill in the art to modify Hayward by making the consumable ordering system within a centralized administrator interface comprising a purchaser as per the teachings of Kageyama so that the consumable status of a variety of peripheral devices can be monitored from a central source, and receive order notification.

Response to Arguments

15. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

16. Applicant argues that Hayward does not teach the elements as arranged in claim 1. Hayward does teach the elements, particularly a computer peripheral device having a messaging system. This is because the claim elements are not particularly defined to operate in a sequence of steps, where one step has to follow another. If applicant wishes to claim a sequence, then the claims should reflect this.

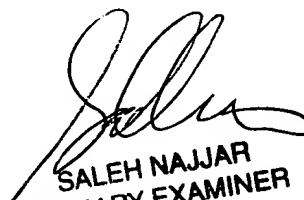
17. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a messaging system between a personal computer and at least one computer peripheral device) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is no mention of the system being between two devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M Osman whose telephone number is (703) 305-8050. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMO
October 14, 2004



SALEH NAJJAR
PRIMARY EXAMINER